

Rejections Under 35 U.S.C. §103(a)

On page 3 of the Office Action, the PTO has rejected claims 1-11, 15 and 16 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,612,104 to Grund (hereafter "Grund") in view of U.S. Patent 4,970,274 to Chacko *et al.* (hereafter "Chacko"). Applicants respectfully traverse this rejection.

As an initial matter, Applicants note that the second full paragraph on page 5 of the Office Action states that "...it would have been obvious to have used the specific block polyetheramides of Chacko et al. in the invention of *Schumacher*...". (Emphasis added). The remarks below presume that the sentence should read "...in the invention of Grund...". [Clarification of these issues is respectfully requested in the next communication from the PTO.]

In addition, as noted above, Applicants currently have no record of filing claims 15 and 16 in this application.

In order to establish a proper *prima facie* case of obvious the PTO must provide some suggestion or motivation to modify a reference or to combine reference teachings. (See MPEP §2143). For the reasons outlined below, the PTO has failed to establish a proper motivation for modifying or combining the cited references.

In setting forth the alleged motivation for combining the references on page 5 of the Office Action, the PTO has taken the position that "[b]ecause Chacko et al. teaches that the film...is easily conformable, yet permits stretching, it would have been obvious to one of ordinary skill in the art to have used the specific block polyetheramides of Chacko et al. in the invention of [Grund] to obtain a sausage casing with the desired stretchable conformability."

Grund relates to a five-layered, tubular casing having inner and outer polyamide layers, a polyolefin core layer and primer layers between the core layer and the inner and the outer layers, respectively. The casing is symmetrical, which means that the inner and the outer polyamide layers have the same composition. The same applies to the two primer layers.

From the PTO's statement of motivation, it is unclear whether the PTO is suggesting that Grund be modified (1) by replacing the five-layered casing of Grund with a single-layered film made with the film disclosed in Chacko, (2) by replacing each of the inner and outer polyamide layers of Grund with the film disclosed in Chacko, or (3) by incorporating the poly(amide-ether) block copolymer of Chacko into the inner and outer polyamide layers of Grund. Throughout the discussion of Chacko on pages 4 and 5 of the Office Action, the PTO refers repeatedly to "the composition" or "the film" and their properties. Nowhere before the statement of proposed modification and motivation for combining the references on page 5, does the PTO provide any discussion whatsoever of the block copolymer taken outside of the context of "the composition" or "the film". As the manner in which the PTO proposes modifying Grund is unclear, Applicants respectfully request clarification in the next communication from the PTO and, pending such clarification, address each of the possibilities, discussed above, in the subsections below.

(1) replacing the five-layered casing of Grund with a single layer film

The remarks in this subsection assume that the PTO is suggesting that Grund be modified by substituting a single layer film of Chacko for Grund's five-layered casing.

A proposed modification, however, may not have the effect of rendering the prior art unsatisfactory for its intended purpose. (See MPEP §2143.01) If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no proper suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Here, the PTO's proposed modification of Grund would render this reference unsatisfactory for its intended purpose. Grund relates to a five-layered casing in which the outer layer is responsible for the high oxygen barrier properties exhibited by the casing. As discussed at column 4, lines 57-62, the outer layer is able to provide the high oxygen barrier properties because it is separated from the filling by the core polyolefin layer. Thus, any combination of Grund and Chacko which would replace the five-layered casing of Grund with a single layer film of Chacko would destroy the oxygen barrier properties attributable to Grund's combination of layers and, therefore,

would be improper. Thus, for the foregoing reason, there is no suggestion or motivation to make the proposed combination.

(2) replacing each of the inner and outer polyamide layers

The remarks in this subsection assume that the PTO is suggesting that Grund be modified by replacing both the inner polyamide layer and the outer polyamide layer of the five-layered casing with the film of Chacko. As discussed above, the PTO has stated that one of ordinary skill in the art would be motivated to combine Grund and Chacko because Chacko's film "is easily conformable, yet permits stretching," and that this modification would result in "a sausage casing with the desired stretchable conformability".

Applicants respectfully disagree with the PTO's position because the properties of the five-layered casing would also be dependent on the polyolefin core layer and primer layers such that it would not be possible to say whether the substitution of the films of Chacko would change anything about the combination of five-layers. As a result, the proposed combination cannot be said to result in the benefit suggested by the PTO, and a person having ordinary skill in the art at the time of the invention would not have been motivated to modify the invention for the reason suggested by the PTO. The PTO has therefore failed to provide a proper motivation for combining these references in the manner discussed here, and the rejection based upon this combination should be withdrawn.

(3) incorporating the poly(amide-ether) block copolymer into Grund's inner and outer layers

The remarks in this subsection assume that the PTO is suggesting that Grund be modified by blending the block copolymer of Chacko into Grund's polyamide inner layer and outer layer.

On page 5 of the Office Action, the PTO's statement that "Chacko et al. teaches that the film [is] widely used for food packaging" mischaracterizes this reference. The only mention of food packaging applications in Chacko appears in the "Description of Related Art" section of the specification and simply relates to polyamides of the prior

art. In this context, the statement clearly refers to polyamides of the prior art and does not address the suitability of Chacko's specific compositions/films compositions in food applications and certainly has no bearing on the suitability of the specific block copolymer taken outside the context of Chacko's compositions/films. For these reasons, the PTO's reliance on this passage as part of its motivation for combining the references is improper or at least insufficient.

In view of the foregoing, Applicants submit that the PTO has failed to provide proper motivation for combining the references and, therefore, has failed to establish a proper *prima facie* case of obviousness. Reconsideration and withdrawal of the outstanding rejections under §103 is respectfully requested.

CONCLUSION

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

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